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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,496	08/15/2006	Anja Schwogler	0690-0133PUS1	9474

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EXAMINER	
MURRAY, JEFFREY H	

ART UNIT	PAPER NUMBER
1624	

NOTIFICATION DATE	DELIVERY MODE
08/21/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/589,496	Applicant(s) SCHWOGLER ET AL.	
	Examiner Jeffrey H. Murray	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/15/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This action is in response to a non-provisional application filed on August 15, 2006. There are twenty claims pending and twenty under consideration. Claims 1-17 are compound Claims. Claim 18 is a use Claim. Claim 19 is a composition Claim. Claim 20 is a method of use Claim. This is the first action on the merits. The present invention relates to novel azolopyrimidine compounds and to their use for controlling harmful fungi, and to crop protection compositions comprising such compounds as active ingredients.

Priority

2. Acknowledgment is made of Applicant's claim for foreign priority. This application is U.S. application 10/589,496 filed August 15, 2006, which is a national stage entry of PCT/EP05/01965, filed February 24, 2005, which claims the benefit of foreign priority to DE 10 2004 009 178.1, filed February 24, 2004.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the

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computer tape used by the printer is limited. 37 C.F.R. 1.72. Appropriate correction is necessary.

4. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

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5. The use of the trademark UNIPERO has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

6. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any of the errors of which applicant may become aware of in the specification.

Claim Rejections - 35 USC § 101 and 112, 2nd

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 18 provides for the use of a compound, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 18 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35

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U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 112, 1st

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1-17 and 19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for azolopyrimidines of the Formula I, does not reasonably provide enablement for azolopyrimidines of the Formula I with specific substituents as described herein below. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The specification describes, but fails to disclose all starting materials required to enable one of skill in this art to prepare all the compounds of the generically recited variety, number and scope. For example, Formula I includes amino/imino azolopyrimidines in which the R¹ and R² substituents include "...5- or 6-membered saturated, partially unsaturated or aromatic heterocyclyl, or heterocyclyl-C1-C4-alkyl which may in each case have 1, 2, or 3 heteroatoms selected from the group consisting of O, S, and N as ring members..." The Y-R¹ and X-R² substituents include "...5-, 6-, or 7-membered saturated or unsaturated carbo- or heterocycle, where the latter may have 1, 2, 3, or 4 heteroatoms selected from the group consisting of O, S, and N as ring members..." R¹¹ and R¹² substituents include "...5-, 6-, or 7-membered saturated or unsaturated

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heterocycle, which may additionally have 1, 2, or 3 heteroatoms selected from the group consisting of O, S, and N as ring members..." The specification describes only certain final products and starting materials for the Formula I (page 41, Table A, p. 67, Table B).

Applicants are required to provide support for all of the final products and all of the starting materials required to prepare all of the 7-amino/imino azolopyrimidines of Formula I encompassed by the claims. Amendment of the claims to comply with the first paragraph of 35 USC 112 is required. Applicants are cautioned against the introduction of new matter into the disclosure of the invention. 35 USC 132(a).

Claim Rejections - 35 USC § 112, 2nd

12. Claim 1, 5, 7, 9, and 19-20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. The last lines of claims 1 and 19-20 recite the phrase "and the agriculturally accepted salts" or "and/or the agriculturally accepted salts." It is suggested to rewrite this phrase as, for example "or an agriculturally accepted salt thereof" to comply with proper Markush language of claiming alternatives.

14. Claim 5, 7 and 9 recites the limitation "hydrogen" in line two of the Claim for R¹ or R². There is insufficient antecedent basis for this limitation in the claim. Claim 1 does not recite R¹ or R² may be a hydrogen, however, it does state that Y-R¹ or X-R² maybe a hydrogen. It is presumed in later Claims that applicant intended to write Y-R¹ or X-R²

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and not simply R¹ or R². It will be presumed that "Y-R¹ or X-R²" will replace the phrase "R¹ or R²" in these Claims.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1-2, 4-5, 11-15, 17 and 19 rejected under 35 U.S.C. 102(b) as being anticipated by Kato et. al. WO 2002040485. The anticipated compound can be seen in the STN structure search as RN 863604-57-3 and RN 863604-58-4.

17. Claims 1-2, 4-5, 15-17, and 19 rejected under 35 U.S.C. 102(b) as being anticipated by Levin et. al., Zhurnal Obshchei Khimi. (1963) 33(8), p.2678-82. The anticipated compound can be seen in the STN structure search as RN 90973-30-1.

18. Claims 1-2, 4-5, 11-12, 15-17 and 19 rejected under 35 U.S.C. 102(b) as being anticipated by Moritoki et. al., JP10101672. The anticipated compound can be seen in the STN structure search as RN 245096-78-0.

19. There are additional 102(b) references in the STN search report which read on the same Claims as the prior art references listed above.

Conclusion

20. Claims 1-20 are rejected.

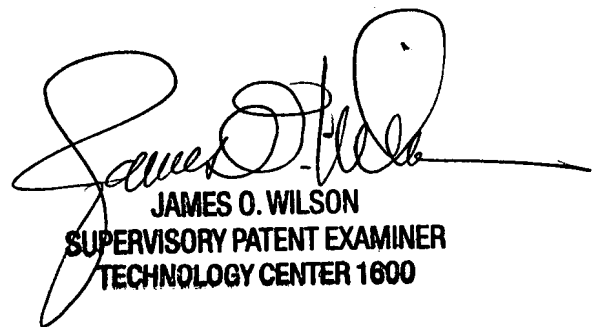
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21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is 571-272-9023. The examiner can normally be reached on Mon-Thurs. 7:30-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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